

Appellant: Fernandez, Dennis)
Application No.: 09/145,167)
Filed: 9/01/1998)
Title: ADAPTIVE DIRECT TRANSACTION)
FOR NETWORKED CLIENT GROUP)

Art Unit: 3628

Attorney Docket No.: FERN-P004

I. *Status of claims*

Claims 1-20 stand cancelled in response to an Advisory Action by the Examiner mailed on 8/22/05.

Claims 21-26 stand finally rejected by the Examiner under the Final Office Action mailed on December 27, 2006 and are the subject of this appeal.

II. *Grounds of rejection to be reviewed on appeal*

A. Whether claims 21, 24, 22, and 25 are unpatentable under 35 U.S.C. 103(a) over Alexander et al. (US 6,177,931), in view of Ballantyne et al. (US 5,867,821), and further in view of Peifer et al. (US 5,987,519).

B. Whether claims 23 and 26 are unpatentable under 35 U.S.C. 103(a) over Alexander et al. (US 6,177,931), in view of Ballantyne et al. (US 5,867,821), in further view of Peifer et al. (US 5,987,519) and further, in view of Hill et al. (US 5,857,155).

III. Argument

Examiner fails to refute Appellant's evidence of "teaching away" from the claimed invention.

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553; 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

In the Appeal Brief (page 15, lines 1-9) Appellant submits objective evidence of teaching-away as secondary consideration of un-obviousness, which in particular "suggests that the transfer of decision support technologies to general practice or to the general public are unlikely to be effective, given the importance of clinical experience to the risk assessment process." (See Abstract of Wood Exhibit).

Appellant respectfully submits that this teaching-away evidence is a significant factor to determine that the claimed invention on-appeal is unobvious, because such evidence teaches away from combining general-practice decision-support technology (Alexander) with specialized-practice clinical/biomedical applications for patient diagnosis (Ballantyne and Peifer). In particular, the Wood reference (page 186, lines 27-30) raises "concern" that discourages the use of decision support tools generally in combination with specialized biomedical expertise decision-making such as doctors or nurses professionally diagnosing and estimating patient risk; and further such reference teaches

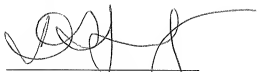
(page 194, line 39 to page 195, line 29) that clinical experience, personal knowledge and even clinician's intuition should "over-ride" decision support devices and software technologies.

In the Answer (page 17, lines 3-17) Examiner proposes to combine Alexander (non-biomedical reference) with Ballantyne and Peifer (biomedical references) because such references are "all directed to the analogous art of delivering targeted video messages to customers."

However based upon expert skepticism raised against the use of general-practice automated decision support tools by specialized professional clinicians in the Wood reference, one skilled in the biomedical arts would thus be discouraged from combining Alexander's non-biomedical system, which is intended only for targeting video messages to customers generally, with Ballantyne and Peifer's biomedical applications, which are intended only for patients/clinicians more specifically.

Accordingly Appellant respectfully submits that it is unreasonable for Examiner to combine Alexander with Ballantyne and Peifer.

Respectfully submitted,



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